REMARKS

On page 2 of the final Action, claims 21-24 were rejected under 35 U.S.C. 112, second paragraphs. In view of the rejection, claims 21, 23 and 24 have been amended to obviate the rejection. Claims 21-24 reflect the explanation on page 31-32.

On page 3 of the final Action, claims 1-11, 33, 34 and 36-41 were rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-3 and 24-26 of U.S. Patent No. 7,253,446(USP '446).

In view of the obvious-type double patenting rejection, claims 33-41 have been canceled. Claims 1-11 should not be rejected by the nonstatutory obviousness-type double patenting. Claims 1-11 of the present application are different from claims 1-3 and 24-26 of USP '446.

The first issue is that the present invention was made by Naoto Hirosaki and filed on March 9, 2005 as the PCT International Application (Priority date is March 12, 2004). On the other hand, USP '446 was made by four inventors including Naoto Hirosaki of the present inventor and filed on February 1, 2006 (Priority date is March 18, 2005).

Namely, the fluorescent substance of claims 1-11 of the application was first made by Naoto Hirosaki, and the light-emitting device of USP '446 using the fluorescent material was later made by four inventors. USP '446 can utilize the present invention, but the present invention was made first and can not invent using USP '446.

In view of the situation, a declaration signed by Naoto Hirosaki has been prepared and filed herewith.

As stated in the declaration, Naoto Hirosaki invented the present invention in Japan about europium-activated β-sialon phosphor and filed a patent application as Japanese Patent Application No. 2004-070894 on March 12, 2004, and subsequently

filed a PCT application PCT/JP 2005/0024596 on March 9, 2005, which was entered in the U.S. National phase as Serial No. 10/564,439 on January 12, 2006.

Before the Japanese application was filed in Japan, the assignee of the present application established a joint research agreement with Fujikura Ltd. on July 1, 2003 about europium-activated α-sialon phosphor and light-emitting device using the same.

Naoto Hirosaki invented another invention with other three inventors based on the joint research agreement and filed Japanese Patent Application No. 2005-079059 on March 18, 2005. Subsequently, the invention was filed in U.S.A. as Serial No. 11/344,126 on February 1, 2006, which was patented on August 7, 2007 as US 7,253,466.

Accordingly, the present invention was made first by Naoto Hirosaki, and then, USP '446 was made by Naoto Hirosaki and three other inventors.

Incidentally, "β-sialon" as stated in the declaration has a broad sense, and means a crystal of nitride or oxy-nitride having a β-type Si_3N_4 crystal structure.

The second issue is that the subject matter of claims 1-11 of the present application invented first is different from that of USP '446 invented second.

In particular, claims 1-11 are directed to a fluorescent substance comprising a crystal of nitride or oxy-nitride using europium-activated β-sialon phosphor, while claims 1-3 of USP '446 are directed to a light-emitting device comprising a semiconductor light-emitting element and a fluorescent material using europium-activated α-sialon phosphor, and claims 24-26 of USP '446 are directed to an illumination apparatus comprising a light source including a light emitting device comprising a semiconductor light-

emitting element and a fluorescent material using europium-activated α-sialon phosphor.

Claims 1-11 of the present application were invented first and are patentably distinct from claims 1-3 and 24-26 of USP '446. Please withdraw the obviousness-type double patenting rejection over USP 446.

On page 4 of the final Action, claims 1-12, 18-20, 25-27, 33, 34 and 36-41 were rejected under 35 U.S.C. 103(a) as being obvious over USP '446.

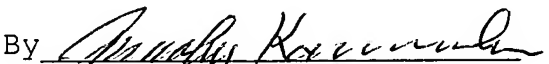
As explained above and shown in the declaration filed herewith, the present invention was made first by Naoto Hirosaki, and subsequently USP '446 was invented by Naoto Hirosaki and other three inventors, as a result of the joint research agreement.

The present invention was made first and the subject matter of claims 1-12, 18-20 and 25-27 are patentably distinct from USP '446. Accordingly, USP '446 can not be cited to the present application under 35 U.S.C. 103(a) based on 35 U.S.C. 102(f) or 102(g).

Claims pending in the application are patentable over USP '446.

Reconsideration and allowance are earnestly solicited.

Respectfully Submitted,

By 

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